REMARKS

Claims 9-12 have been canceled. Claims 1-8 remain pending in the application. Applicants amend claims 1-2, 4, and 6-7 for further clarification, and refer to page 23, lines 8-14 in the specification for exemplary embodiments of and support for the claimed invention. No new matter has been added.

Claims 1-8 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The Examiner stated that the specification failed to support the claimed feature of the attribute data excluding rights and fee information, as recited in claims 1-2, 4, and 6-7. But the cited portion—p. 22, lines 8-13—of the specification includes description of exemplary embodiments of the claimed invention, where one of ordinary skill in the art can readily understand that the claimed attribute data may include any one or more of the provided examples of the attribute data, while excluding others. Thus, Applicants respectfully submit that the specification provides ample support for the objected-to claim feature, but Applicants amend the claims to remove the feature for expediency. Accordingly, Applicants respectfully request that the Examiner withdraw the § 112 rejection.

Claims 1 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,634,012 to Stefik et al. in view of U.S. U.S. Patent No. 7,010,808 to Leung et al.; and claims 2-5 and 7-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Stefik et al. in view of Leung et al., and further in view of U.S. Patent No. 5,872,588 to Aras et al. Applicants amend claims 1-2, 4, and 6-7 in a good faith effort to further clarify the invention, and respectfully traverse the rejections.

The Examiner acknowledged that Stefik et al. fail to:

> "disclose that the usage rights and fees information is middleware, which gives a predetermined function to the user terminal, embedded to said contents, said middleware

> including one or more programs providing functionality to said user terminal to perform the usage right tasks." Page 6, lines 3-6 of the Office Action.

And the Examiner relied upon Leung et al. as a combining reference that allegedly suggests these features. But the cited portions of Leung et al. only include description as follows:

> "A need exists, then, for providing an enforcement architecture and method that allows the controlled rendering or playing of arbitrary forms of digital content, where such control is flexible and definable by the content owner of such digital content." Col. 2, lines 15-19;
>
> "The authoring tool 18 is employed by a content owner to package a piece of digital content 12 into a form that is amenable for use in connection with the architecture 10 of the present invention. In particular, the content owner provides the authoring tool 18 with the digital content 12 instructions and/or rules that are to accompany the digital content 12, and instructions and/or rules as to how the digital content 12 is to be packaged. The authoring tool 18 then produces a digital content package 12p having the digital content 12 encrypted according to an encryption/decryption key, and the instructions and/or rules that accompany the digital content 12." Col. 6, lines 12-24; and
>
> "The instructions and/or rules that are to accompany the digital content 12 may include practically any appropriate instructions, rules, or other information without departing from the spirit and scope of the present invention. As will be discussed below, such accompanying instructions/rules/information are primarily employed by the user and the user's computing device 14 to obtain a license 16 to render the digital content 12. Accordingly, such accompanying instructions/rules/information may include an appropriately formatted *license acquisition* script or the like, as will be described in more detail below." Col. 7, lines 18-28. (Emphasis added)

Thus, Leung et al. only provides for the content owner to enter "instructions/rules" based upon which the content is provided, which "instructions/rules" are still only directed "to obtain a license to render the digital content" and, thus, relies upon separate functionality for providing such a license and utilizing the corresponding content, etc. Furthermore, Leung

et al. explicitly describe separate entities for providing and interrogating—"license evaluator 36"—such a license:

> "a Digital Rights License (DRL) 48 (i.e., the rights description or actual terms and conditions of the license 16 written in a predetermined form that the license evaluator 36 can interrogate), perhaps encrypted with the decryption key (KD) (i.e., KD (DRL));" col. 20, lines 43-47 of Leung et al.

And the DRL is described as follows:

> "</DRLDATA>
> </DATA>
> <SIGNATURE>
> <SIGNERNAME>Universal</SIGNERNAME>
> <SIGNERID>9382</SIGNERID>
> <SIGNERPUBLICKEY></SIGNERPUBLICKEY>
> <HASHID>MD5</HASHID>
> <SIGNID>RSA 128</SIGNID>" Col. 29, lines 51-59 of Leung et al.

Thus, both Stefik et al. and Leung et al. would only have suggested a system that requires discrete dedicated entities—hardware or components—for obtaining and interrogating licenses for usage permission of corresponding content. And neither reference would have suggested the claimed features in connection with embedded middleware independently providing standalone functionality for utilization and usage tracking of the content.

In other words, even assuming, arguendo, that it would have been obvious to one skilled in the art at the time the claimed invention was made to combine Stefik et al. and Leung et al., such a combination would still have failed to disclose or suggest,

> "[a] method for managing fees of contents in which the fees arise based on a predetermined charging rule upon distributing the contents, said method comprising the steps of:
> equipping information gathering means on a network with which a user terminal is allowed to connect, said user terminal carrying out information processing by utilizing said contents;
> embedding ***middleware***, which independently provides a predetermined function to the user terminal, to said contents, said ***middleware*** including one or more programs

independently providing standalone functionality to said user terminal to autonomously monitor, and store, a contents utilizing history at the user terminal, and transmit the stored contents utilizing history along with identification information to said information gathering means at a predetermined timing while said user terminal is connected with said network;

processing a plurality of said contents, in each of which the middleware is embedded, to one archive data;

selectively encrypting said archive data and adding an attribute data to the encrypted archive data;

distributing said archive data and attribute data through a predetermined distribution mechanism;

holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism;

counting a distribution condition of contents per distribution mechanism based on said contents utilizing history gathered through said information gathering means and said identification information held by said identification information holding means; and

determining a charging amount per distribution mechanism based on said counted distribution condition and a charging rule for said contents,

wherein the contents utilizing history is stored permanently as long as the contents is utilized, and

the attribute data indicates one or more of a genre of corresponding content, a type of corresponding content, a distribution mode of corresponding content, and a condition of transaction of corresponding content," as recited in claim 1. (Emphasis added)

Accordingly, Applicants respectfully submit that claim 1 is patentable over Stefik et al. and Leung et al., separately and in combination, for at least the foregoing reasons. Claim 6 incorporates features that correspond to those of claim 1 described above, and is, therefore, patentable over the cited references for at least the same reasons.

The Examiner cited Aras et al. as an additional combining reference to specifically address the respective additional features recited in claims 2-5 and 7-8. And claims 2, 4, and 7 incorporate features that correspond to those of claim 1 described above. As such, a further combination with Aras et al. would still have failed to cure the above-described deficiencies of Stefik et al. and Leung et al., even assuming, arguendo, that such a further combination

would have been obvious to one skilled in the art at the time the claimed invention was made. Accordingly, Applicants respectfully submit that claims 2, 4, and 7, together with claims 3, 5, and 8 dependent therefrom, respectively, are patentable over the cited references for at least the above-stated reasons.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

/Dexter T. Chang/
Dexter T. Chang
Reg. No. 44,071

CUSTOMER NUMBER 026304
Telephone: (212) 940-6384
Fax: (212) 940-8986 or 8987
Docket No.: SCEW 18.968 (100809-16279)
DTC:tb